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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,530	01/17/2001	Robert Berliner	169-274	6423

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FULBRIGHT AND JAWORSKI L L P  
PATENT DOCKETING 29TH FLOOR  
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EXAMINER

HO, THOMAS Y

ART UNIT PAPER NUMBER

3677

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/764,530

Applicant(s)

BERLINER, ROBERT

Examiner

Thomas Y Ho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,5-8,10,11 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,10,11 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

Claims 1, 5-8, 10-11, and 14-17 are currently pending. Claims 2-4, 9, 12-13, and 18 have been withdrawn or cancelled.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 5-7, 10-11, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koprowski (Wall Street Journal, 1998) in view of Allsop US5970472.**

As to claim 1, Koprowski discloses: a method (p. 3 of 4) of doing business on the world wide web, comprising: providing information on a web site about the repair of various devices wherein a user can click on displayed graphics representing a replaceable part of a device, said graphics being in the form of a photograph or other illustration depicting the device, depicting a plurality of parts thereof, and depicting the relationship of said parts to the device, wherein when clicking on a displayed part, the user can purchase the part needing replacement; and deriving revenue from making one or more of said items of information available by one or more of the following activities: (a) direct sale of one or more replacement parts to the user, (b) obtaining referral fees or commissions from a manufacturer or other vendor of the one or more of the parts, or (c) gathering consumer information from the user's activities on the web site.

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The difference between the claim and Koprowski is the claim recites: information comprising a list of a plurality of manufacturers or vendors is made available to the user, and wherein the user can obtain information, by clicking one of the manufacturers or vendors in the list. Allsop discloses a method and system for electronic commerce similar to that of Koprowski. In addition, Allsop further teaches information comprising a list of a plurality of manufacturers or vendors is made available to the user (Col. 7, Ln. 24-40; Col. 8, Ln. 34-40), wherein the user can obtain information, by clicking one of the manufacturers or vendors in the list. It would have been obvious to one of ordinary skill in the art, having the disclosures of Koprowski and Allsop before him at the time the invention was made, to modify the parts website in Koprowski to link to a list of manufacturers or vendors, as in Allsop. One would have been motivated to make such a combination because it can be an alternative to direct sales (Col. 1, Ln. 65-67; Col. 2, Ln. 1-10).

As to claim 5, Allsop teaches: wherein the user is directed to a web site of the manufacturer or vendor.

As to claim 6, Allsop teaches: wherein the web site of the manufacturer or vendor is its site home page.

As to claim 7, Allsop teaches: wherein the web site of the manufacturer or vendor is a site page on which information on the product is displayed.

As to claim 10, Koprowski discloses and Allsop teaches: wherein by clicking one of the manufacturers or vendors, the user is directed to an order page.

As to claim 11, Koprowski discloses: an internet web site, comprising: a plurality of web site pages providing information about the repair of various devices wherein a user can click on

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displayed graphics representing a replaceable part of a device, said graphics being in the form of a photograph or other illustration depicting the device, depicting a plurality of parts thereof, and depicting the relationship of said parts to the device, wherein when clicking on a displayed part, a user can purchase the part needing replacement by clicking clickable regions on one or more web site pages enabling revenue to be derived from making one or more of said items of information available by one or more of the following activities: (a) direct sale of one or more replacement parts to the user, (b) obtaining referral fees or commissions from a manufacturer or other vendor of the one or more of the parts, or (c) gathering consumer information from the user's activities on the web site.

Allsop teaches: information comprising a list of a plurality of manufacturers or vendors of the item selected by the user is made available to the user, and wherein the user can obtain information about the item or purchase the item by clicking one of the manufacturers or vendors in the list.

As to claim 14, Allsop teaches: wherein the user is directed to a web site of the manufacturer or vendor.

As to claim 15, Allsop teaches: wherein the web site of the manufacturer or vendor is its site home page.

As to claim 16, Allsop teaches: wherein the web site of the manufacturer or vendor is a site page on which information on the part is displayed.

**Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koprowski (Wall Street Journal, 1998) in view of Allsop US5970472, and further in view of Messer US5991740.**

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As to claim 8, the difference between the claim and Koprowski is the claim recites: wherein the web site of the manufacturer or vendor is a site page specifically set up to receive referrals from another web site and to compensate the owner of the referring web site. Messer discloses a method and system for carrying out electronic commerce similar to that of Koprowski. In addition, Messer further teaches a site page set up to receive referrals from another web site and to compensate the owner of the referring web site (Col. 3, Ln. 25-30; Col. 4, Ln. 47-60; Col. 9, Ln. 50-55). It would have been obvious to one of ordinary skill in the art, having the disclosures of Koprowski and Messer before him at the time the invention was made, to modify the web page of Koprowski to link to a vendor web site, as in Messer. One would have been motivated to make such a combination because the ability of widespread advertising and promotion for a part/item would be achieved, as taught by Messer.

As to claim 17, Messer teaches: wherein the web site of the manufacturer or vendor is a site page specifically set up to receive referrals from another web site and to compensate the owner of the referring web site.

### ***Response to Arguments***

Applicant's arguments filed 8/25/04 have been fully considered but they are not persuasive.

The Applicant argues (p. 5) that both Koprowski and Messer teach away from the claims. The Examiner respectfully disagrees. Neither Koprowski nor Messer alone discloses or suggests all of the claimed limitations, however a reference's failure to disclose a claimed element is not equivalent to the reference teaching away from the claim. The Applicant asserts that Koprowski refers to a web site of a single manufacturer, and it would be contrary to Koprowski's purpose to

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have a list of other manufacturers displayed at that point. This assertion by the Applicant is unsupported by Koprowski. Koprowski in no way requires the replacement parts to be made by a single manufacturer.

The Applicant argues (p. 5) that Messer fails to disclose the claimed limitations, and does not suggest that a part number is displayed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., displaying of part numbers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant argues (p. 6) that the combination of Messer with Koprowski fails to suggest the need for a list of manufacturer's to be displayed, and nothing in Messer suggests the need for a display of parts. First, the previous version of the claims could be anticipated by showing a single manufacturer or vendor (the Applicant claimed "one or more"), as opposed to the pending claims that require a plurality of manufacturers or vendors. Allsop has been provided in a new combination rejection, and teaches the newly claimed limitation of linking to a plurality of manufacturers or vendors. Second, nothing in Messer suggests the need for a display of parts because Koprowski already discloses the display of parts.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Y Ho whose telephone number is (703)305-4556. The examiner can normally be reached on M-F 10:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J Swann can be reached on (703)306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TYH

  
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